

### REMARKS

Claims 1-4, 13, 15-28 and 31-32 stand rejected as obvious over U.S. Patent No. 4,174,175 ("DiMaria") in view of U.S. Patent No. 5,652,901 ("Slayden"). Applicant respectfully requests reconsideration.

DiMaria teaches a copier machine in which the hard copy document to be copied is placed on a glass plate. The hard copy document is illuminated to project an image of the document onto a screen that is viewed by the operator of the copier machine. DiMaria does not teach anything about receiving or previewing electronic documents.

Slayden teaches a computer program that provides three preview modes: zoom, single page, and multiple page.

Claim 1 requires receiving in a computer a user input that selects an instruction for assembling a hard copy document, and determining in the computer a visual appearance of an electronic document as if printed and assembled in accordance with the instruction.

Applicants acknowledge that the previewing of electronic documents is part of the prior art. For example, the WordPerfect 5.1 program included a preview feature that would display how the document would appear when printed (e.g., with fonts and print sizes that could not be displayed due to constraints of the application and operating system). More recent word processing programs, such as Word 6.0, include "WYSIWIG" (i.e., "what you see is what you get") interfaces that can display text in different fonts and print sizes and thus generally obviate the need for a separate preview function.

However, to Applicants' knowledge, both the original preview functions and the newer WYSIWIG interfaces simply display the pages of the electronic document as if printed on plain white paper. It is important to note that these conventional interfaces do not display the electronic document as it would appear once printed and assembled. By assembled, Applicants refer to some sort of physical activity that would typically be performed (e.g., by a print or copier shop or an office services department) on the printed hard copy media, and not to the mere act of printing the electronic document to generate the hard copy. For example, the interfaces do not show how the document would appear if hole punched or stapled (as taught in FIGS. 2D, 2E and 2F of Applicants' specification).

The Examiner argues that the combination of DiMaria with Slayden renders the

claims obvious. Applicants traverse the Examiner's argument. Although the claims may be broad, the cited references do not show the concept of displaying an electronic document as if printed and assembled, and consequently Applicants should be entitled to broad claims.

Applicants request reconsideration in view of the following remarks.

First, DiMaria does not receive an electronic document. DiMaria teaches placing a hard copy document onto the glass plate of a copier. The image on the document is physically projected onto a screen with optics. The hard copy document is not scanned or converted into any electronic form. Thus, DiMaria never receives or creates any electronic document.

Second, neither DiMaria nor Slayden teach receiving a user input that selects an instruction to assemble a hard copy document. The passage quoted by the Examiner only teaches that an operator can physically position papers on the glass cover plate of a copier machine. This is not receiving a user input or a selection of an instruction to assemble a hard copy document. At best, in the context of an electronic document, this would be equivalent to the positioning of text or an image on a document page. It does not suggest instructions for assembling the hard copy document before or after printing, e.g., by choosing the printing media, stapling, hole punching or the like. Since neither DiMaria nor Slayden teach receiving a user input that selects an instruction to assemble a hard copy document, the combination of the two references cannot render the independent claims obvious.

Third, DiMaria does not teach determining the visual appearance of an electronic document. Since DiMaria is a copier with a physical projection system, it simply does not perform this step. Although Slayden does teach determining the visual appearance of an electronic document as if printed, Slayden does not teach determining the visual appearance of the electronic document as it would appear as if printed and assembled in accordance with the instruction. Since neither DiMaria nor Slayden teach determining the visual appearance of an electronic document as it would appear as if printed and assembled in accordance with an instruction, the combination of the two references cannot render the independent claims obvious.

Fourth, it is well established that references cannot be combined where the combination would fundamentally change the operating principles of one of the devices. Since DiMaria operates by physically projecting an image onto a display screen, changing DiMaria to an electronic scanning system would change the operating principles of the device. Therefore a

person of ordinary skill in the art would not combine DiMaria with Slayden.

Fifth, it is well established that references cannot be combined without a motivation. The Examiner has not suggested any motivation to combine the references. It appears that the Examiner has performed a text-based search for a patent containing the word “assemble”, and then made an ad hoc combination based on hindsight.

In short, there is simply no suggestion from the references that an electronic document could be shown as it would appear once stapled, hole punched, or the like. In view of the foregoing, Applicants submit that the claims are allowable and requests that the rejection of the of the independent claims be withdrawn.

With respect to many of the dependent claims, the Examiner states the user “had the freedom” to identify various instructions. This is an improper grounds for rejection. Even if the DiMaria device had the capability to accept some sort of assembly instructions, which it does not, mere capability is insufficient to form the basis of an obviousness rejection. It is axiomatic that for an obviousness rejection, a reference must show or suggest the claimed subject matter. Neither DiMaria nor Slayden show or suggest anything about selecting a printing media, selecting bindings, or selecting physical modifications of the printing media, or the other aspects of the dependent claims. Therefore the dependent claims should be allowable.

Applicant submits that all of the claims are now in condition for allowance, which action is requested.

If prosecution can be advanced telephonically, for example, by discussion of the differences between the claimed invention and the references, the Examiner is invited to contact the undersigned at 650-322-5070.

Please charge any additional fees, or make any credits, to Deposit Account No.

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Respectfully submitted,

Date: 1/3/00

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